

Appl. No. 09/787,452
Any. Docket No. 7628
Amdt. dated 10/29/2003
Reply to Office Action of 7/30/03

REMARKS/ARGUMENTS

Claims 1, 3-6 and 8 are now in the case. Claims 1 and 3 have been amended to delete the "about" language objected to by the Examiner, and to make the term "composition" singular.

Rejection Under 35 USC 112, first paragraph

Claim 1 stands rejected under the first paragraph of §112, for reasons of record at page 2 of the Office Action. The Examiner takes the position that there is an enablement issue with regard to the claim, noting, "There is no other guidance given to the reader as to how to make this invention."

Applicants respectfully traverse the rejection on this basis.

As noted at MPEP 2164.04:

A specification disclosure which contains a teaching of the manner and process of making and using an invention in terms which correspond in scope to those used in describing and defining the subject matter sought to be patented must be taken as being in compliance with the enablement requirement of 35 USC 112, first paragraph, unless there is a reason to doubt the objective truth of the statements contained therein which must be relied on for enabling support.

The specification herein contains three working Examples which describe how to make the composition of the invention. (Page 18) In addition, the specification is replete with further instructions on how to make the claimed compositions using various agglomeration, fluidized bed, etc., processes. (Page 9, l. 28 to p. 14, l. 26)

Once the composition is made, it can, of course, be tested to ensure that it meets the definitional parameters of Claim 1 (pages 6-9). Such testing would be routine, given the instructions in the specification. MPEP 2164.06. However, it is submitted that, at that stage, the composition has, in fact, already been made, thereby meeting the "how to make" requirement of §112.

In short, it is submitted that Claim 1 meets §112, first paragraph. Reconsideration and withdrawal of the rejection on this basis are requested.

Rejection Under 35 USC 112, second paragraph

Claim 1 also stands rejected for reasons of record (the "about" language) at page 3 of the Office Action.

Appl. No. 09/787,452
Atty. Docket No. 7628
Amdt. dated 10/29/2003
Reply to Office Action of 7/30/03

It is submitted that the amendments presented herewith fully meet these rejections, and that they should be withdrawn. The Examiner's helpful suggestions in this regard are acknowledged.

Rejection Under 35 USC 102/103

Claims 1, 3-10 and 12 stand rejected over WO 98/35004 ("WO 98") and, separately, over U.S. 5,569,645 ('645), for reasons of record at pages 4-5 of the Office Action. The rejections are under §102 or, alternatively, §103.

Applicants respectfully traverse all rejections.

The Examiner has acknowledged that there is no teaching of particle geometry with respect to homogeneity number, circularity and aspect ratios in WO 98 or in '645. However, the Examiner maintains that the granular detergents of WO 98 or '645 inherently possess these values within the presently claimed range, noting that, "Applicants have not demonstrated that they do not."

Before turning to the substance of the rejections, attention is directed to the Board's decision in *Ex parte Schricker*, 56 USPQ2d 1723 (BPAI 2000).

With regard to the current inherency rejection being under §102 or §103, the Board addresses this specific point at page 1725 [1]. The Board notes:

Inherency and obviousness are somewhat like oil and water – they do not mix well.

As stated by the Board at p. 1725, five lines earlier, inherency, "...is really an anticipation rationale...." Accordingly, it is respectfully submitted that §103 is not a proper grounds for the inherency rejections in the instant case. Withdrawal of the rejections on the basis of §103 is requested.

Furthermore, the Board additionally notes at p. 1725 [1]:

However, when an examiner relies on inherency, it is incumbent on the examiner to point to the "page and line" of the prior art which justifies an inherency theory.

In apparent contrast to the Board, the Examiner has taken the position that the burden is on Applicants to demonstrate that the homogeneity number of the present compositions would not inherently be associated with the compositions of WO 98 and '645.

To the contrary, it is respectfully submitted that *Schricker* stands for the proposition that it is the Examiner's duty to point to the "page and line" of WO 98 and '645 that would necessarily lead to a conclusion of inherency.

Appl. No. 09/787,452
Atty. Docket No. 7628
Amdt. dated 10/29/2003
Reply to Office Action of 7/30/03

Furthermore, it is submitted that, while the Examiner has focused on the asserted inherency of the homogeneity number, the present claims are further defined by the particle circularity, the aspect ratio, and the product of the circularity times the aspect ratio. Again, it is respectfully submitted that it is the Examiner's duty to point to the "page and line" of WO98 and/or '645 that would justify a rejection based on an inherency theory encompassing all these parameters.

In this regard, the relevant case law also requires that:

Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient. *In re Robertson*, 49 USPQ2d 1949 (Fed. Cir. 1999)

Moreover, it is improper to establish prior invention when there is an absence of evidence that the alleged prior inventors appreciated at the time of their work all the elements of the invention. *Schering Corp. v. Precision - Cosmet Co. Inc.*, 614 F. Supp. 1368, 227 USPQ 278 (D. Del. 1985). It is submitted that, neither WO 98 nor '645 appears to appreciate the defining elements of the present invention.

Turning to the WO 98 document, the disclosure relates to solid detergent compositions which can contain a cationic surfactant. (Abstract) The compositions are taught to be in a variety of physical forms including granular, tables, flake or particle forms. (Page 47, last paragraph.) The compositions can be made by a variety of methods, including spray-drying, dry-mixing, extrusion, agglomerating and granulation. (Page 48, second paragraph.) When the particle size is specified, the particles are said to be preferably made by an extrusion process. (Page 48, penultimate paragraph.)

It is respectfully submitted that the foregoing disclosure of WO 98 regarding the manufacture of the disclosed compositions does not meet the tests for inherency set forth in the *Schricker*, *Robertson*, and *Schering* cases cited above. Therefore, it is the Examiner's duty to point to the "page and line" of WO 98 which justifies an inherency theory for the rejection. Absent this, reconsideration and withdrawal of the rejection on this basis are requested.

With regard to '645, this document relates to low dosage, highly dense detergents comprising spray dried granules, agglomerates and adjunct ingredients, in specified amounts and proportions. (Abstract) The agglomerates are prepared in the manner disclosed at Col. 16 and are then taught to be admixed with the spray dried granules. Additional liquid adjunct detergent ingredients are thereafter sprayed on to form the finished composition. (Col. 18, l. 5-10)

Appl. No. 09/787,452
Atty. Docket No. 7628
Amdt. dated 10/29/2003
Reply to Office Action of 7/30/03

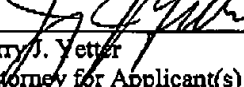
It is submitted that nothing in the simple agglomerating/admixing procedure of '645 would lead one of skill in the art to conclude that a finished product having the definitional parameters specified herein would necessarily (*Robertson*) be produced.

It summary, it is submitted that nothing in either of the cited references, taken singly or in combination, teaches or suggests the present invention under §103. Reconsideration and withdrawal of the rejections on this basis are requested.

In light of the above amendments and remarks, it is requested that the Examiner reconsider and withdraw all rejections. Early and favorable action in the case is respectfully requested.

Respectfully submitted,
Capeci et al.

RECEIVED
CENTRAL FAX CENTER
OCT 29 2003

By 
Jerry J. Yetter
Attorney for Applicant(s)
Registration No. 26,598
(513) 627-1907

OFFICIAL

October 29, 2003
Customer No. 27752